

REMARKS

The Examiner and his supervisor, Mr. Cabeca, are once again thanked for the courtesies extended during a personal interview on June 17, 2003. A summary was prepared by the Examiner and provided to Applicant and Applicant's representative at the conclusion of the interview. The Examiner graciously indicated that upon receipt of a response after final, which was filed August 8, 2003, the arguments presented therein would be given further consideration in light of the discussions that took place on June 17, 2003. The Examiner thus issued an Advisory Action dated August 26, 2003 setting forth further reasoning with respect to certain rejections. Applicant's remarks and further arguments with respect to the May 8, 2003 Final Rejection and the August 26, 2003 Advisory Action are set forth below. These remarks and further arguments are supplemented by the Declaration of Edward F. Seitz, submitted currently herewith. Additionally, an IDS providing additional references for the Examiner's consideration is also being filed currently herewith. Screen shots of a particular item of prior art in operation are also appended to this paper.

Presently, claims 53 through 68 and 77 through 86 are pending in this application. Claims 1 through 52 and claims 69 through 76 have previously been cancelled. Claim 85 is herein amended, and new claims 87 through 113 are herein presented.

Prior to turning to the substantive arguments pertaining to the presently rejected claims, the following brief legal background is provided.

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Anticipation under 35 U.S.C. § 102 may be found only where a reference explicitly or inherently recites all of the elements of a claim against which a reference is applied. See e.g. In re Robinson, 169 F.3d 743 (Fed. Cir. 1999). Anticipation by inherent disclosure, however, is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation. Transclean Corp. v. Bridgewood Services, Inc., 290 F.3d 1364 (Fed. Cir. 2002). See also Trintec Industries Inc., v. Top-U.S.A. Corp., 295 F.3d 1292 (Fed. Cir. 2002).

A claim may be rendered obvious under 35 U.S.C. § 103 by combining the teachings of more than one reference in the presence of a teaching, suggestion or incentive supporting the combination. See e.g. Carella v. Starlight Archery, 804 F.2d 135 (Fed. Cir. 1986). The mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. See MPEP § 2143.01, citing In re Mills, 916 F.2d 680 (Fed. Cir. 1990). Further, even if the cited references relied upon by the Examiner do in fact teach the individual components of the rejected claims, (a fact that is in no way conceded in the present instance), that fact alone is also not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teaching of the references. Thus, the Examiner can satisfy this burden “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” In re Lee, 277 F.3d 1338, 1343, citing In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. based 1992). As In re Lee requires, as does In re Zurko, 258 F.3d 1379, 1383-86, the Examiner must set forth with

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specificity where the motivation exists in the cited references, or, if the Examiner is relying on general knowledge of the art, that general knowledge must be capable of readily documented substantiation. If the Examiner is relying on well-known facts or common knowledge in the art to provide the motivation, such facts and knowledge must be of a nature that are “capable of instant and unquestionable demonstration as being well-known.” MPEP § 2144.03.A., citing In re Ahlert, 424 F.2d 1088, 1091 (CCPA 1970) (requiring that the notice of facts beyond the record which may be taken by the Examiner must be capable of instant and unquestionable demonstration so as to defy dispute).

Further, the Examiner in the Final Office Action at page 11, cites In re McLaughlin, 443 F.2d 1392 (CCPA 1971,) for the principle that all obviousness rejections “in a sense necessarily” require a reconstruction based upon hindsight reasoning. It is respectfully submitted that this interpretation of the case is not altogether accurate. The principles of McLaughlin require that the Examiner place himself in the shoes of a person of ordinary skill in the art at the time the invention was made. It is this hindsight to which the McLaughlin case refers, which hindsight, in the context of McLaughlin, limits the Examiner only to that which was known to the person of ordinary skill at the pertinent time to which the rejection applies. As the Courts have amply set forth subsequent to McLaughlin, the Applicants’ invention may not be used as the hindsight roadmap with which the Examiner winds his way through the prior art for identifying features and then, using the teachings of the claimed invention, “use that which the inventor has taught against its teacher” to provide the missing motivation to combine the references to yield the

claimed invention. In re Lee, 277 F.3d 1338, 1344, citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1993). As the Federal Circuit stated in In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999);

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See e.g., C.R. Bard, Inc. v. M3 Sys., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1998) (evidence of teaching or suggestion “essential” to avoid hindsight)...Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. See e.g., Interconnect Planning Corp., v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”)

Further, the measurement of a claimed invention against the standard of §103 “requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field”. Id. at 999. (Emphasis added)

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Turning now to claims 61-63 and 66, which were previously rejected under 35 U.S.C. §102(e) as being anticipated by Burner, the undersigned respectfully reiterates that Burner is not a proper anticipatory reference, nor does Burner render claims 61-63 and 66 obvious. As discussed, and, it is respectfully submitted, as the Examiner recognized during the interview, the invention of Burner is in fact a piece of client software that is described as providing a floating toolbar that provides additional functionality to a user as the user traverses the Internet. The Examiner sets forth in the Final Rejection that the Burner toolbar could be displayed “along with” the Internet browser toolbar while the browser is activated regardless of the Internet sites to which the computer is connected. This fact does not disclose or suggest the inventions claimed in claims 61-63 and 66. The user toolbar of the inventions recited in those claims is displayed as part of the Internet browser interface in addition to the Internet browser toolbar that is provided as part of the native browser interface. It is respectfully submitted, based upon the discussions held during the interview, that there is no dispute with the Examiner in connection with what the browser interface of an Internet browser comprises. The subject inventions of claims 61-63 and 66 recite additional functionality provided via a user toolbar that is displayed “as part of the Internet browser interface along with and in addition to the Internet browser toolbar”. The Burner reference merely teaches a floating toolbar in a separate window, which is not a user toolbar that is displayed as part of the Internet browser interface along with and in addition to the native Internet browser toolbar. In connection with the Examiner’s comments at the interview that the Burner toolbar could possibly be “dragged” across the screen and positioned in the space

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occupied by the Internet browser, this is not in any way a user toolbar that is displayed as part of the Internet browser interface. Were a user to perform the suggested repositioning of the Burner toolbar, the Burner toolbar would in fact necessarily obscure either a portion of the native browser interface or the Internet content being viewed with the browser, a clear disadvantage and a shortcoming overcome by the inventions of claims 61-63 and 66. (See appended Screenshot 2, further discussed below). Burner in no way teaches or suggests a user toolbar as part of the browser interface. Thus it is respectfully submitted that the Examiner should reconsider his §102 rejection as to Burner, since a toolbar that floats in a window separate and apart from a browser interface does not teach or suggest the inventions as presently claimed. Nor does Burner render the inventions of claims 61-63 and 66 obvious since Burner is completely devoid of a recognition of the problem and solution recited by those claims, namely a user toolbar with additional functionality as part of the browser interface along with and in addition to the Internet browser toolbar. Since Burner has no teaching or suggestion of the desirability of such a feature, Burner also cannot render claims 61-63 and 66 obvious.

Further, with respect to the Examiner's contention that the fact that the Burner toolbar could be implemented as "an extension of the browser or as browser plug-in software" also anticipates claims 61-63 and 66, this was also discussed at the interview. It is respectfully submitted that since Burner merely teaches client software to implement a floating toolbar, the fact that it could be implemented as an extension of the browser or as a browser plug-in does not

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teach that the Burner toolbar should be implemented as part of the browser interface as is recited in claims 61-63 and 66.

Further to this argument, the Examiner, in the aforementioned Advisory Action, in discussing the Burner reference with respect to claims 61-63 and 66 as well as other claims to which Burner was applied, posits that Burner teaches that the floating toolbar software:

may be implemented as an extension of the browser or as browser “plug-in” software. Burner further explains in column 8: lines 23-37 that the invention could operate in a secondary instance window of the conventional web browser. *The Examiner interprets both statements as positive indication that Burner recognized at least one possible advantage of implementing the invention directly into the browser interface. Otherwise there would have been no reason to make note of the implementations in the first place.*

Advisory Action, page 1. (Italic emphasis added, bolded text in original).

With respect to these comments, it is respectfully submitted that the Examiner is reading a technical interpretation of these terms into the Burner reference that is simply not present. In short, a person of ordinary skill reading the Burner reference would not interpret the term browser plug-in, extension or secondary instance window to in any way teach, describe or suggest that the Burner toolbar should be implemented as part of the browser interface as recited in the claims under discussion. The citations in Burner are entirely consistent with the teaching of Burner, simply that the Burner software could be implemented as a plug-in, extension or in a secondary instance window. That is why these implementations are mentioned, not to imply, as the Examiner mistakenly asserts, that the toolbar should be added to the browser interface.

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As set forth in the Declaration Under 37 C.F.R. § 1.132 of Edward F. Seitz, which is submitted concurrently herewith, Mr. Seitz explains that a person of skill in the art in October of 1998, the time the provisional patent from which the pending application claims priority was filed, and even thereafter would simply not associate the terms plug-in, extension or secondary instance window as meaning a software application that modifies a browser user interface. In paragraph 7 of his Declaration, Mr. Seitz describes that in his opinion a person of ordinary skill in October 1998 would be a person with a undergraduate degree in Computer Science or Engineering, having taken sufficient coursework to develop a proficiency in programming and/or scripting, along with several years of pertinent experience writing GUI-based applications in the Windows or Apple environment along with a working understanding of the Internet and programs capable of operating over and with the Internet, such as commercially available Internet browsers like Explorer and Netscape. Mr. Seitz's educational background, which is set forth in paragraphs 5 and 6, and as further set forth in paragraph 8, clearly delineates Mr. Seitz as a person of ordinary skill. Mr. Seitz sets forths in paragraphs 9 and 10 that he has reviewed the Burner reference and the rejections set forth by the Examiner in connection therewith.

In paragraph 11 of the Seitz Declaration, Mr. Seitz makes reference to Exhibit A and B of his Declaration, which exhibits are definitions obtained through the Internet of the term plug-in. Exhibit A of the Seitz Declaration shows a definition having a date of May 1996, while the definition of Exhibit B shows a date of January 2002. It should be noted that the definitions are essentially the same, indicating that the use of the term plug-in in 1996 has stayed consistent

since that time. As evidenced by the Seitz Declaration, and as discussed with the Examiner during the interview and in prior responses during the pendency of this application, the fact that the Burner reference indicates that the Burner client software can be implemented as a plug-in merely connotes that the application program of Burner could be added to a computer system and connected to a browser application to add functionality to the browser application. It is respectfully submitted, and as amply supported by the Seitz Declaration, that the term "browser plug-in" did not mean to a person of ordinary skill "something that is added to a browser user interface". A person of ordinary skill interprets the term browser plug-in merely as software that runs on a client computer with a browser to add functionality to the browser. This is precisely what the Burner toolbar does, no more, no less. It is respectfully submitted that the Examiner is incorrect in his technical understanding of the term plug-in as evidenced by the concurrently submitted definitions accompanying the Seitz Declaration and paragraph 11 thereof. Respectfully, the Examiner has applied an untenable meaning to the term plug-in in the context of the Burner reference.

The same is true with respect to the term extension. With reference once again to the Seitz Declaration, and particularly to Exhibits C and D thereto, there are submitted definitions of the term extension as found on the Internet. Seitz Exhibit C, which provides the definition of the term extension as of June of 1997, defines an extension as a feature or piece of code that extends a program's functionality, for example, a plug-in. This definition is similar to the definition represented in Exhibit D dated September of 2002. Thus, the term "extension" is not defined as

“a piece of software that is added to a browser to modify the user interface”. This position is further supported by paragraph 12 of the Declaration of Ed Seitz, in which Mr. Seitz indicates that the Burner reference teaches that the Burner toolbar, which exists in a separate window, can be implemented through client software that operates as an extension of the browser. The use of the term extension does not describe nor teach nor suggest nor would it motivate a person of skill in the art in October of 1998 to implement the Burner toolbar as incorporated as part of the browser user interface as claimed. The Seitz Declaration clearly indicates that the term “extension” does not mean “something that is added to a browser user interface”, nor would a person of skill in October of 1998 understand that term in the manner that the Examiner has propounded. Thus, as supported by the Seitz Declaration, and the Exhibits thereto, it is respectfully submitted that the Examiner is incorrect in his technical understanding of the term extension as evidenced by the common definitions submitted with the Seitz Declaration and thus the Examiner has, respectfully, applied an untenable meaning to that term in the context of the Burner reference.

In the same vein, the Examiner has taken the same position with respect to the term secondary instance window. Referring now to paragraph 13 of the Seitz Declaration, Mr. Seitz explains that in the context of the Burner patent at column 8, lines 23-37, Mr. Seitz’s interpretation as a person of skill is that the term secondary instance window relates to the opening of a second browser window using a Windows based operating system which is how the Burner toolbar is shown and described in the embodiment of the Burner patent. This is bolstered

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by the fact that the described secondary instance window is used as an alternative to the proxy server embodiment described earlier in the Burner patent at column 8, lines 8-22. This suggests to Mr. Seitz, a person of skill in the art, that the term secondary instance window, as used in context at the portion of the Burner reference relied upon by the Examiner, relates to opening a second instance of the browser. This does not in any way teach or describe or suggest that the floating toolbar of Burner should be implemented as part of the browser user interface as claimed.

Thus, it is respectfully submitted, as supported by the Seitz Declaration, that the terms plug-in, extension and secondary instance window do not in any way connote, describe, teach or suggest to a person of skill in the art, now or in October of 1998, that the floating toolbar of Burner should be added to the browser user interface as claimed.

If the Examiner believes that these terms were known in October of 1998 to mean a modification of the user interface, the Examiner is respectfully requested to produce evidence in the record evidencing this understanding of those terms in the art at the time of filing. See MPEP, §§ 2144.03.A through C. See also In re Zurko 258 F.3rd 1379 (Fed. Cir. 2001); In re Ahlert, 424 at 2nd 1088 (CCPA 1970).

Alternatively, if the Examiner's basis for rejection based on the aforementioned three terms as used in Burner is that such terms inherently disclose an addition to the browser user interface, the Examiner is respectfully requested to definitively state his reliance on the inherency

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principle, and the Examiner is further respectfully requested to come forth with evidence as to why the Burner reference necessarily discloses a toolbar added to the browser user interface as claimed. Specifically, in order to sustain anticipation by inherent disclosure, the reference lacking the explicit element that the Examiner believes is inherently disclosed must necessarily flow from the practice of the prior art. See Transclean Corp. v. Bridgewood Services, Inc., 290 F.3rd. 1364 (Fed. Cir. 2002). Indeed, the Federal Circuit has stated that inherency may be not established by probabilities or possibilities, and the mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish a case of inherency or inherent anticipation. In re Robinson, 169 F.3rd 743 (Fed. Cir. 1999). Indeed, Applicant has set forth via the concurrently filed Declaration of Ed Seitz ample evidence of the fact that a person of skill in the art would not interpret the reference as the Examiner has, and Applicant put forth extrinsic evidence indicating that the terms used in the Burner reference do not in fact teach what the Examiner states they teach. The extrinsic evidence demonstrates that the missing descriptive matter is not “necessarily present” in the cited reference nor would it be recognized as so by a person of ordinary skill. Id. Thus, it is respectfully requested that if the Examiner is relying on a theory of inherency, and will not withdraw the present rejections in light of the evidence submitted herewith and discussed above, the Examiner should come forth with evidence indicating that the three terms used in the Burner reference and relied upon by the Examiner for inherent anticipation of claims 61-63 and 66 mean what the Examiner is stating they mean, so that this evidence may be made of record. This will afford the Applicant an opportunity to

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further refute or to provide additional evidence. In doing so, it is once again emphasized that the test is not that the missing subject matter may or could result in a given set of circumstances, but that the missing subject matter must necessarily result from the inherent information upon which the Examiner is relying. In the present case this means that the Examiner must come forward with evidence proving that client-side software implemented as a browser plug-in, a browser extension, or in a secondary instance window, necessarily results in an addition to the browser interface as claimed. See Transclean, Robinson, Trintec, supra.

It is respectfully submitted given the information above that the Applicant has clearly met its burden in the present instance of demonstrating how a person of skill would understand the Burner reference, and why the Examiner's reading of the Burner reference is incorrect.

It is further respectfully submitted that the fact the Burner reference discloses that client software can be implemented as a browser extension or browser plug-in or in a secondary instance window does not necessarily teach the inventive claimed toolbar of claims 61-63 and 66 which provides additional functionality in a user toolbar displayed as part of the browser interface along with and in addition to the native browser toolbar. Withdrawal of the rejections to these claims is earnestly requested.

In further support of the above-noted position with respect to the terms plug-in, extension and secondary instance window, the Examiner's attention is respectfully directed to paragraph 15 of the Seitz Declaration. In that paragraph, Mr. Seitz sets forth additional reasons as to why a

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person of skill would not have interpreted those three terms as indicating that a toolbar could or should be added to the user interface of a browser as available in October 1998 (or even thereafter). As Mr. Seitz discusses, while it is now widely recognized that browsers have been modified by their manufacturers to include tools or application programming interfaces to permit end users or software developers to modify the browser interface by inserting toolbars or interface object that are not part of the native browser software as supplied, such capability was not available until after the filing of the present patent application. For this additional reason, it is respectfully submitted that the Examiner is incorrect in his position with respect to how a person of skill would understand the terms plug-in, extension and secondary instance window since at the time of filing of the present application, it was not commonly known that the browser interface could be modified by the addition of a toolbar or an interface object.

Referring again to paragraph 15 of the Seitz Declaration, Mr. Seitz refers to information submitted concurrently as part of an Information Disclosure Statement and which is attached to the Seitz Declaration as Exhibit E. Exhibit E presents printouts of message exchanges between computer users of what are known as user groups, through which a person in the art may exchange ideas and seek opinions of their peers. While some of the threads precede the filing of the present application, others postdate the filing of the present application. These threads clearly demonstrate, as Mr. Seitz set forths in paragraph 15, that it was not commonly recognized that toolbars could be added to the browser interface. These threads make reference to a commercial embodiment of the presently claimed invention known as Yahoo! Companion. Even after the

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commercial release of such product, which was after October of 1998, these threads are indicative of and support Mr. Seitz's position that person of skill did not recognize that the browser interface could or should be modified to add a toolbar as claimed in the present application, even though, as the Examiner has found, the terms plug-in, extension and secondary instance window were in use at that time. It is respectfully submitted that this is further evidence that the terms plug-in, extension and secondary instance window as used in the Burner reference and elsewhere do not teach, describe or suggest or connote adding a toolbar to the browser interface as claimed.

This position is also bolstered by the Burner reference itself, which, as recognized by Mr. Seitz in paragraph 16 of his Declaration, does not contemplate any other implementation than a separate window outside of the browser interface. Thus, nothing in the Burner patent suggests anything other than the separate window embodiment as described and depicted therein, and the terms relied upon by the Examiner do not teach otherwise for the reason set forth above. Reconsideration of the rejection and allowance of claims 61-63 and 66 is earnestly requested.

With respect to claims 53, 77 and 84, and claims depending therefrom, the Examiner has rejected those claims as obvious under 35 U.S.C. §103 as being unpatentable over Burner et al. and the Alexa Internet Website reference ([web.archive.org/web/19980209015002/...](http://web.archive.org/web/19980209015002/)). The undersigned submits that the arguments presented above with respect to Burner are equally applicable to the inventions of claims 53, 77 and 84, as well as the claims depending therefrom,

which all stand rejected on obviousness grounds. In light of the shortcomings set forth above with respect to Burner, which are not cured by the Alexa reference (nor has the Examiner applied the Alexa reference in this regard), claims 53, 77 and 84 should be considered allowable and withdrawal of the rejections based on the argument presented above is earnestly requested.

Turning to the specific rejection, however, the Examiner, in combining references, indicates that the Burner reference fails to disclose providing access to the client software disclosed by Burner at a predetermined Internet site and making that software available for download by the user. However, the Examiner submits that the Alexa Internet Website reference describes providing access to specific software for “adding a user toolbar to their Internet browser interfaces”. This quoted language is found nowhere in the applied reference, and the undersigned respectfully requests the Examiner to more specifically point out where this alleged teaching may be found in the Alexa reference. It is respectfully submitted that the Alexa Internet Website reference does not in fact describe downloading a user toolbar that may be added to and become part of the Internet browser interface as claimed, but rather the reference discloses a software tool that operates “in parallel with, and independently of Web browsers, and is displayed as a toolbar on the user’s desktop”. (Alexa Internet Website reference, page 1, paragraph 4). It is respectfully submitted that this quotation clearly shows that this reference does not teach that the Alexa toolbar is or can be a toolbar that is added to an Internet browser interface of the existing browser on the user’s computer, which is the aim of the inventions recited in claims 53, 77 and 84. Indeed, Alexa is the assignee of the Burner reference which, as

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pointed out above, describes the Alexa toolbar as existing in a separate window which floats on the user's desktop and is not described as operating as part of the browser interface. Thus the Alexa Internet Website reference is describing the same functionality as Burner, which is merely a floating toolbar available in a window on a user's desktop and not as part of the Internet browser interface, a distinguishing feature which sets apart the presently claimed inventions. Thus, even if the hypothetical combination of those references were made, the fact that the Burner or Alexa software is downloadable still would not meet all of the limitations of claims 53, 77 and 84, nor those depending therefrom, because the downloaded Burner/Alexa toolbar is still described as a floating, window-based desktop toolbar that is not presented as part of the Internet browser interface as claimed. (See discussion re: Burner presented above.) Thus, it is respectfully submitted that the proposed combination suggested by the Examiner of the Burner and Alexa Internet Website reference does not teach or suggest the claimed user toolbar which is displayed as part of the browser interface. The proposed hypothetical combination of the Burner and Alexa Internet Website references merely provides a downloadable window-based toolbar that, as recognized by the Examiner, may be repositioned by the user, but if the Burner toolbar were to be repositioned in the manner suggested by the Examiner, it would obscure part of the native browser interface or the Internet content, under which circumstances it would demonstrably not be part of the Internet browser interface as claimed.

Annexed to this Preliminary Amendment are color screen shots taken from the undersigned's computer which show what the undersigned believes to be an implementation of

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the Alexa toolbar available as of June 1998. A copy of the June 1998 Alexa software on CD-Rom, as well as the identification of a website archive from which a download of the software may be obtained, (See Screenshot 3) is being submitted as part of a concurrently filed IDS. As is clearly evidenced from the screen shots, the Alexa toolbar exists outside the browser environment and, as seen in Screenshot 1, where two instances of the browser exist, the Alexa toolbar floats outside the browser windows and does not replicate as each new browser window is opened. (Note that in Screenshot 1 a user toolbar in accordance with the present invention, indicated by an arrow, does appear with the user interface of the browser in each instance of the browser.) This clearly demonstrates that in June of 1998 the Alexa toolbar, as apparently referenced in the article cited by the Examiner, was not made part of the browser user interface or the browser at all but merely existed outside the browser environment as a floating window. As evidenced by Screenshot 2, when a single browser window is opened and maximized, the Alexa toolbar can be seen floating at the bottom of the browser overlying the website content normally viewable in the portion of the browser that displays page content. While the Alexa toolbar may be dragged to alternate locations, all such locations overly the browser either in the user interface portion or in the content portion, and thus the Alexa toolbar clearly does not appear as part of the user interface as claimed in all of the aforementioned presently rejected claims. Screenshot 4 appended hereto shows the contents of a directory of the files being submitted concurrently herewith, as well as an indication of the date of last modification of the executable file that generated the Alexa toolbar, which can clearly be seen by the Examiner is Monday, June 8, 1998.

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The Examiner is invited to interact with this Alexa software to demonstrate to the Examiner's satisfaction that the Alexa toolbar from June of 1998 in actual implementation does not in any way become part of the Internet browser interface as claimed. Thus, it is respectfully submitted that the proposed combination of the Burner and Alexa Website references upon which the Examiner relies for rejecting claims 53, 54, 56, 57, 77, 78, 79, 81, 82, 84 and 85 under 35 U.S.C. §103 is untenable, and reconsideration of the Examiner's position and allowance of these claims is earnestly requested.

Additionally, with respect to claim 85, it was discussed during the interview that the Examiner had taken official notice of the fact that browsers, upon loading, are frequently directed to a pre-programmed "homepage" or predetermined website. Applicant did not traverse taking official notice of that fact per se, since such functionality is recognized in the prior art. However the undersigned respectfully submits that the Applicant did adequately traverse such official notice with respect to any suggestion that a browser going to a predetermined homepage upon loading in any way teaches or suggests that a user toolbar which is not part of the native Internet browser should go to a predetermined website upon loading to receive information for defining all or part of an interface object as claimed.

The Examiner further discusses this issue in the Advisory Action at page 1. To clear up any confusion, and to address the Examiner's concern in this regard, claim 85 has been amended to claim that it is the downloaded file that establishes the link to the predetermined Internet site

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in order to receive information from the predetermined Internet site for defining all or part of an interface object. The undersigned submits that this claim, as amended, and taken as a whole, is neither anticipated by homepage navigation nor rendered obvious by any proposed combination of references, since no such combination is motivated by any reference and the known fact of homepage navigation, see, e.g., Lee, Zurko, supra., nor does such combination yield all of the elements claimed.

As recited in amended claim 85, the action taken upon activation of the browser is not the action of directing the browser to a predetermined homepage but rather the user toolbar file being activated with the native Internet browser and the user toolbar file being directed to a predetermined Internet site to define components of the toolbar. Thus, the official notice taken by the Examiner is not an adequate anticipatory fact that would, alone or in addition to the Burner or Alexa website reference, teach the features as recited in presently amended claim 85. Nor would the proposed combination be obvious since there is no teaching or suggestion of such functionality in the cited references or in the noticed fact of pre-programmed language navigation. Id. It is respectfully requested that the Examiner's position with respect to claim 85 be reconsidered in light of the amendment made and the arguments above, and the discussions had at the interview, and claim 85 be passed to allowance.

With respect to claims 55 and 80, which stand rejected as unpatentable under 35 U.S.C. §103 based on the combination of Burner, the Alexa Internet Website reference and Ko et al., it

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is respectfully submitted that the features described above with respect to claim 53 (from which claim 55 depends) and claim 77 (from which claim 80 indirectly depends) are applicable to these claims as well, and that claims 55 and 80 are allowable for the same reasons as set forth above. Thus the fact that Ko teaches the use of active scripting to implement custom software does not teach or suggest the deficiencies in the hypothetical combination of Burner and the Alexa Internet Website reference as proposed by the Examiner and dealt with above. Thus, it is respectfully requested that the Examiner reconsider his position with respect to claims 55 and 80 for the reasons set forth above in connection with the claims from which claims 55 and 80 depend. Moreover, claim 80 contains the additional limitation of the claimed interface object enabling a user to customize the claimed user toolbar, an element not found in either of the three applied references. Thus claim 80 should be found allowable for this additional reason.

Turning next to the rejection of claims 58 and 83, these claims stand rejected under 35 U.S.C. §103 as being unpatentable over the combination of Burner et al., the Alexa Internet Website reference, both of which were discussed above, and further in view of the Microsoft Internet Explorer 4 reference. Initially, in light of the arguments above, these claims should now be allowable as depending from an allowable base claim, and withdrawal of the rejection on this ground is earnestly requested.

Turning to the specific rejection however, as discussed during the interview, and as set forth in the Final Rejection, the Examiner's position is that Microsoft Internet Explorer 4

contains a search button as part of a native browser toolbar, and as set forth in the final Office Action, the Examiner states that the Internet Explorer 4 reference discloses in Fig. 3.11 on page 42 "an entire browser toolbar dedicated to searching at a predetermined Internet site regardless of the site to which the browser is connected". As discussed during the interview, and as reiterated here, the undersigned emphatically traverses such a characterization of the Internet Explorer 4 capability. As set forth in the Internet Explorer 4 reference, and as is clearly seen in the cited figure, the Internet Explorer 4 reference does not in any way disclose a user toolbar having a search window that enables the user to initiate a search at a predetermined Internet site, that site being the site from which the user toolbar was downloaded. Rather, as described in the Microsoft Internet Explorer 4 reference, what exists in the depicted Internet Explorer browser interface is a search button as part of a native browser toolbar. When the user clicks on the search button, a window in the browser known as an Explorer Bar is opened and the user is presented with a drop down menu, which drop down menu contains links to Internet sites that provide Internet search capability. After a user selects the particular Internet site that the user wishes to conduct a search through, the search page of the Internet site selected by the user is displayed in the browser window as a webpage. The user may then enter search terms in the search window provided as part of the HTML page provided by the search website selected. Thus, the claimed functionality of claims 58 and 83, which recite the capability of initiating a search via a search window provided as part of a downloaded user toolbar displayed as part of the browser interface is significantly different from the ability to enter a search term on an

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Internet webpage provided by a search website, as was and still is commonly done. There is simply nothing in any of the references combined by the Examiner, specifically the Burner reference, the Alexa Internet Website reference, and the Internet Explorer 4 reference, that in any way teaches or suggests the desirability of implementing the extremely efficient functionality of incorporating a search window as part of a user toolbar as part of the browser interface. As pointed out during the interview, the functionality as claimed in claims 58 and 83 eliminates the necessity for the user to first click on a search button, then select a search website through a drop down menu, receive a downloaded web page, and then initiate a search in the search field provided as part of a web page downloaded by the Internet search site selected by clicking in the drop down menu. This is an inordinate number of steps to take to execute a search, as compared to the ability to enter a search directly into a search window provided in a user toolbar that is provided as part of the browser interface. Clearly the Examiner must agree that in Internet space, saving "clicks" provides significant advantages over techniques that require more complex navigation. The inventions of claims 58 and 83 provides significant advantages over the technique presented in the proposed three-reference combination recited by the Examiner. It is respectfully submitted that none of the three references provides adequate motivation or teaching or even suggestion for the inventions recited in claims 58 and 83, which make the search window part of an added user toolbar presented as part of the browser interface, thereby eliminating the burdensome steps described in the Internet Explorer 4 reference. Additionally, even if the

proposed combination of references made by the Examiner were proper (a fact not conceded), the combination would not yield the claimed invention of claims 58 and 83.

In further discussion with respect to these claims, the Examiner in the Advisory Action provided a broad definition of a toolbar and then applied this definition to figure 3.11 of the Internet Explorer (Que) reference. It is once again respectfully submitted that the search area described in figure 3.11 is in fact an HTML page loaded into a window pane of a browser and the search text entry area is provided as part of the webpage of the site to be searched, and not the browser interface. With further reference to the Seitz Declaration, and specifically with respect to paragraphs 17 and 18, Mr. Seitz describes the stark technical differences in the use of the native Explorer Bar functionality of Internet Explorer 4, which merely provided access to pull-down menus to facilitate searching at existing website pages as was known in the art. Specifically in paragraph 18 Mr. Seitz describes how utilizing the claimed invention, which incorporates a search window directly into a toolbar made part of the user interface avoids the ponderous steps of utilizing the rather primitive Explorer Bar functionality provided in the native Explorer 4 implementation described in the Internet Explorer reference. As was previously argued, and it is believed recognized by the Examiner at the personal interview, the elimination of the relative complexity of utilizing the Explorer Bar functionality of Internet Explorer 4 is starkly different from the claimed invention. In conformance with Mr. Seitz's view as one of ordinary skill, the cumbersome method described in the Internet Explorer 4 reference would not in any way describe or teach or suggest the claimed invention, which makes the search window

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always available regardless of where the user is navigating and allows the user to enter the search term without any clicks or menu selection. It is respectfully submitted that the Internet Explorer 4 reference cannot anticipate the claimed invention for the reasons set forth above, nor does the combination proposed by the Examiner yield the claimed invention.

Additionally, the Examiner has failed to set forth adequate evidence as to why the proposed three reference combination of the Burner reference with the Alexa Internet website reference and the Microsoft Internet Explorer 4 reference should be made. As both the Board and the Federal Circuit have continuously reaffirmed,

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

Carella v. Starlight Archery and Pro Line Co., 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986) (citing *ACS Hosp. Syss., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). “[T]he factual inquiry whether to combine references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 262 F. 3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). This factual question cannot “be resolved on subjective belief and unknown authority,” *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002); “it must be based on objective evidence of record.” *Id.* at 1343, 61 USPQ2d at 1434.

Ex parte Metcalf, 67 USPQ2d 1633, 1635 (B.P.A.I. 2003). See also Zurko, supra.

As set forth in the above quotation and with reference to the cases cited therein, in order for a proper obviousness determination to be made, the Examiner must set forth explicitly where the motivation exists to combine the references that the Examiner contends would, when combined,

yield all of the elements as claimed in the rejected claims. It is respectfully submitted that the Examiner has provided no motivation whatsoever for making the proposed combination and thus the combination is improper both for the reasons that there is no motivation, and also for the reason that even were the combination to be made the claimed invention would not result. For example, the Federal Circuit, in In re Lee, stated that “when patentability turns on the question of obviousness, the search for an analysis of the prior art includes evidence relevant to the finding of whether there is a teaching motivation or suggestion to select and combine the references relied on as evidence of obviousness .” In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). The Court went on to state that “the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” Id. (internal citations omitted).

It is respectfully submitted that the Examiner, in relying on the Internet Explorer 4 reference, is utilizing the term toolbar to apply to the search window functionality provided by the HTML webpage that appears in the Explorer Bar window pane when a search provider is selected and the search provider downloads the HTML page to the Explorer Bar window. It is respectfully submitted that this is not technically or functionally the same as providing a text entry window in the user interface of the browser so that a search term may be entered into the search window without the necessity to involve multiple navigation steps before a search term may be entered into the search window. In short, neither the Burner or Alexa reference contain any suggestion that search functionality should be added to the floating toolbar disclosed in those

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references, and the Microsoft Explorer 4 reference merely teaches entering search terms on a webpage after multiple navigation steps, not directly into a toolbar, much less a downloadable toolbar added to the browser interface to provide functionality not found in the browser prior to download. It is respectfully submitted, in accordance with the precepts of Lee, Zurko, and Dembiczak, supra., and the other obviousness cases cited herein, that there is no motivation present in either the Alexa reference, the Burner reference or the Internet Explorer reference to modify the references to yield the claimed invention as presently claimed in claims 58 and 83, and the rejections to these claims should be withdrawn.

In the Advisory Action at page 2, the Examiner in further discussing the rejections to the aforementioned claims, states that “even if the Examiner were to concede that the [Internet Explorer 4] reference fails to anticipate the claimed invention, the previously cited Belfiore reference teaches a search window within the Internet Explorer toolbar.”

It is respectfully submitted that the Belfiore reference, which describes functionality provided with the native Microsoft Explorer browser, is directed to causing the browser to execute a search if the URL entered into a browser address bar is not a known URL. This functionality is starkly different from that claimed, in that the address bar functionality described in the Belfiore reference is not described in the context of a separate user toolbar search window but rather is described in the context of the address bar which is a common feature to all browsers and which permits a user to enter Internet locations to which the browser should be

directed. With further reference to the Seitz Declaration, and with reference to paragraphs 19-21, Mr. Seitz describes the teachings of the Belfiore reference. Belfiore teaches a feature that is incorporated into a native browser that causes the browser to execute a search if the URL entered into the browser address bar is not an known URL. If the term entered into the browser address bar is a known URL, the page is served as usual, meaning that no search is performed and the browser is directed to the address entered and website pages are obtained from the website that exists at the address entered. If the URL entered into the browser address bar returns an error, meaning the URL is not known, the browser then tries to format the term into a proper URL. If that effort is unsuccessful, the system will apply a template to construct its own search query (not one entered by the user), that is passed to a search engine that is pre-programmed by the browser provider.

As Mr. Seitz set forth, and as is evidenced from a reading of the Belfiore reference, the person of skill in the art as of October of 1998 reading the Belfiore reference would not consider the address bar of a browser to describe or teach or suggests the invention as presently claimed in claims 58 and 83 which are directed to the provision of a search window that is incorporated into a downloadable toolbar or interface object and that permits the search terms to be entered knowing that the search will be provided at the predetermined website from which the download was obtained. In the presently claimed invention, the user knows that when text is entered a search will be performed. As Mr. Seitz points out, and as is evident from a reading of the Belfiore reference, the Belfiore system does not ensure that when text is entered a search will be

performed, but rather if a term is entered that matches a URL, a new page will be served. This is clearly the function of the address bar in a browser. With the presently claimed invention when a search term is entered, a search is performed at a predetermined website with the user expectation that a search result will be returned. The undersigned respectfully submits that a fair reading of the Belfiore reference indicates that a person of skill in the art would consider the functionality that is presently claimed and the functionality taught in the Belfiore reference to be quite different. Mr. Seitz's Declaration, from the perspective of a person skill in the art, is further support of this position.

Additionally, and as Mr. Seitz points out in paragraph 21 of his Declaration, if the Belfiore address bar were considered a search window as the Examiner suggests, a position that is in no way conceded, then a person of skill reading Belfiore would clearly not be motivated to add yet another search window to the browser since a second search window would be redundant. Thus, rather than motivate a person of skill to add a search window to a browser user interface via a downloadable toolbar or interface object, Belfiore, if interpreted as the Examiner has interpreted it, in fact teaches away from such an addition since such functionality would already be present. Once again the stated combination of references lacks a sufficient basis for such combination, see e.g. Lee, Zurko, Dembiczak, supra, and it is respectfully submitted that the rejections to claims 58 and 83 be withdrawn.

Moreover, it is respectfully submitted that even if the unmotivated combination of Burner, the Alexa reference and Belfiore were made, it would not yield the invention as claimed. If in fact the teachings of Belfiore were added to the floating toolbar of Alexa and Burner, what would result is a floating window incorporating an address bar within which URLs could be entered to affect navigation of the browser. Moreover, the Burner reference appears to teach, in figure 10, that a user of the floating toolbar may add website addresses to a menu provided with the floating toolbar to affect navigation. Thus, since the functionality appears to exist in the Burner floating toolbar to add URLs to a list to affect navigation, it is unclear why the user of the Burner floating toolbar would require another address field as provided by the Belfiore reference. Moreover, the Belfiore reference does not teach or describe or suggest that the functionality provided therein should be applied to a downloadable user toolbar, since Belfiore is exclusively directed at augmenting the address bar of a native browser, and since, as described above and as set forth in the Seitz Declaration in paragraph 15, at the time of filing of the present application it was not commonly known how to even cause a downloadable toolbar to be added to the browser user interface. Thus the three references lack motivation for combination, fail to yield to the claimed invention even if combined, and do not adequately teach how the proposed combination can be modified to yield the claimed invention. See Lee, Zurko and the cases presented at pages 20-24 herein.

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It is respectfully submitted that claims 58 and 83 are clearly patentable over the proposed combinations and reconsideration of the Examiner's position and allowance of claims 58 and 83 is earnestly requested.

With respect to claim 64, the same arguments presented above with respect to claims 58 and 83 are applicable, although, as the Examiner pointed out in the Final Office Action, the Alexa Internet Website reference is not implicated in the combination. Nonetheless, for the same reasons presented above in connection with the hypothetical combination of references, the undersigned submits that the arguments presented above with respect to claims 58 and 83 apply equally to claim 64, and for those reasons the rejection of claim 64 under U.S.C. §103 is untenable and should be withdrawn as well.

Turning next to the rejection of claims 59 and 60, these claims stand rejected as being unpatentable under 35 U.S.C. § 103 based upon the combination of Burner, the Alexa Internet Website reference, and MacNaughton et al. Claims 59 and 60 depend from claim 53, and thus, the arguments made above in connection with claim 53 are equally applicable here, and these claims should be found allowable for the same reasons.

Turning to the specific rejection, however, with respect to the features absent from claim 53, the MacNaughton reference does not provide any teaching or suggestion of the claim features missing from base claim 53 as discussed above. As cited above, in order to sustain an obviousness rejection, the Examiner must provide evidence of where the motivation to combine

the reference can be found. Lee, Zurko, Dembicczak, supra. Thus, for that reason alone, the rejection of claims 59 and 60 should be withdrawn. Further, MacNaughton does not, as the Examiner suggests in the Final Rejection, teach storing user information that is used to populate a toolbar. It is respectfully submitted that a review of columns 9 and 10 of the MacNaughton reference as cited by the Examiner reveals that the “user information” referred to by the Examiner (which it is believed is discussed at column 9, lines 53 through column 10, line 16) are capabilities that are provided through the web pages a community member interacts with, and not with a user toolbar as claimed in the subject claims. As this was not addressed in the Advisory Action it is not clear if the MacNaughton reference will still be relied upon by the Examiner. It is respectfully submitted, however, that the MacNaughton reference contains no teaching of a downloadable toolbar that may be displayed as part of the browser interface and which toolbar display is dependent upon user-specific information stored at the predetermined website from which the toolbar was downloaded. Should the Examiner persist in this rejection it is respectfully requested that the Examiner specifically point out where such a teaching exists in MacNaughton. Thus the proposed hypothetical three-reference combination upon which the Examiner has relied to reject claims 59 and 60, it is respectfully submitted, does not result in a teaching or suggestion of all of the claim limitations of claims 59 and 60, or even claim 53 from which these claims depend. Moreover, the Examiner has failed to set forth any specific motivation to make the proposed three-reference combination. See, e.g. Lee, Zurko, Dembicczak, supra. Thus, it is respectfully urged that the rejections to claims 59 and 60 also be withdrawn.

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With respect to the rejection of claim 65, it is respectfully submitted that this claim is patentable for the same reasons as presented above in connection with claim 62 from which claim 65 depends. The arguments presented with respect to claims 55 and 80 above are also applicable to claim 65. It is respectfully urged that the rejection of claim 65 be withdrawn.

With respect to claim 67, it is respectfully submitted that the arguments presented above with respect to claim 62 as well as claims 59 and 60 and 85 as set forth above, are equally applicable to the rejection of claim 67, and for those reasons the rejection of the 35 U.S.C. § 103 with respect to claim 67 should also be withdrawn.

With respect to claim 68, this claim stands rejected under 35 U.S.C. §103 as being unpatentable over the combination of the Burner, MacNaughton, and Guyot references. Claim 68 depends, through claim 67, from claim 62, and it is respectfully submitted that claim 68 is allowable for the reasons presented above with respect to those claims from which claim 68 depends. Additionally, the Guyot reference does not, as the Examiner sets forth, teach or suggest that “it is well known to periodically reconnect to an Internet server to download the most recent information and apply it to an application interface.” Such a feature, it is respectfully submitted, is not found in the reference, but if the Examiner in relying on general knowledge, the Examiner is respectfully requested to substantiate this claim. It is respectfully submitted that in the Guyot reference the information being “updated” is related to pop up advertisements and not an application interface, and especially not a browser interface having as part thereof a user toolbar

with interface objects therein as is recited in the invention of claim 68. (As this was not addressed in the Advisory Action it is not clear if the Guyot reference will still be relied upon by the Examiner.) Thus, it is respectfully submitted that there is no teaching or suggestion in Guyot to periodically connect to a predetermined Internet site that provides a downloadable, updateable user toolbar that exists as part of the browser interface in addition to the native browser toolbar, as is claimed in claim 68. Should the Examiner persist in this rejection, the Examiner is requested to respectfully point out where such a teaching exists in Guyot or in the body of general knowledge. Additionally, it is respectfully submitted that the Examiner has failed to set forth any specific motivation found in the references or in the art to make the proposed three reference combination. See Lee, Zurko, Dembiczak, supra. Accordingly, for the reasons set forth above, it is respectfully submitted that the rejection to claim 68 should be withdrawn.

With respect to claim 86, which depends from claim 53 through amended claim 85, it is respectfully submitted that claim 86 is allowable for the reasons set forth in connection with the claims from which claim 86 depends. It is further submitted that the arguments presented directly above with respect to claim 68 are equally applicable to claim 86, and for these reasons it is respectfully urged that the Examiner reconsider his position and withdraw the rejection of claim 86 under 35 U.S.C. §103 as well.

Once again, the undersigned thanks the Examiner for the courtesies extended during the interview, and hopes the Examiner found the interview process helpful in pointing out the

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specific novel features of the inventions as presently claimed, and why the prior art cited by the Examiner does not teach or suggest the inventions as presently claimed. Again, it is respectfully submitted that the inventions described in the claims discussed above, which each relate to a user toolbar presented as part of the browser interface, are nowhere taught or suggested in the prior art of record. It is hoped that in light of the interview, the Seitz Declaration and IDS submitted concurrently herewith, the amendment and the above remarks, the Examiner will reconsider his position with respect to the claims and place them in condition for allowance.

To further advance prosecution, this Amendment also presents new claims 87 through 113, which, it is respectfully submitted, should also be found patentable over the art of record. Should the Examiner not be inclined to allow all now-pending claims, the Examiner is respectfully urged to call the undersigned at 212-806-5742 to discuss the matter.

Respectfully submitted,

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